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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/989,007	11/21/2001	Judith C. Clark	4812.100	9546
28410	7590	05/30/2006		
BERENATO, WHITE & STAVISH, LLC 6550 ROCK SPRING DRIVE SUITE 240 BETHESDA, MD 20817				
			EXAMINER	
			SPERTY, ARDEN B	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/989,007

Applicant(s)

CLARK, JUDITH C.

Examiner

Arden B. Sperty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 89 and 91-122 is/are pending in the application.
- 4a) Of the above claim(s) 101-118 and 122 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 89, 91-100, 119-121 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

FINAL OFFICE ACTION

1. Applicant's comments and amendments, filed 3/16/06, have been entered and carefully considered.

Election/Restrictions

2. Newly submitted claims 101-107 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 101-107 are drawn to a coupling apparatus comprising a barrette, a backer, and a fastener. The invention is unrelated to the examined invention, because the inventions do not share the same particulars. The coupling apparatus of the elected and examined invention includes a tying element having first and second ends. Claims 101-107 require no such tying element, and are therefore drawn to an **independent or distinct invention**.

3. Newly submitted claims 108-118 are directed to an invention that is an independent or distinct species from the invention originally claimed for the following reasons: Claims 108-118 are drawn to an invention which is a **different species** than the examined invention. The coupling apparatus of the elected and examined invention includes a tying element having first and second ends, while claims 108-118 require an elastic band.

4. Claim 122 is directed to an invention that is an independent or distinct species from the invention originally claimed for the following reasons: Adhesive strip fasteners are a **distinct species** from the hook and loop fastener embodiment currently

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examined. Interlocking fasteners and adhesive strips are listed as alternative coupling mechanisms in claim 119. According to MPEP 803.02, a Markush-type claim may include independent and distinct inventions. This is true where two or more of the members are so unrelated and diverse that a prior art reference anticipating the claim with respect to one of the members would not render the claim obvious under 35 U.S.C.103 with respect to the other member(s). Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

5. Accordingly, claims 101-118 and 122 are withdrawn from consideration as being directed to inventions non-elected by original presentation. See 37 CFR 1.142(b) and MPEP § 821.03. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits.

6. It is further noted that new claim 119 is broader than claim 89, because 119 does not specifically require hook and loop fastener.

7. The currently examined claims are: 89, 91-100, 119-121.

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 99 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim appears to be redundant. It is not clear what is intended beyond that which is required in claim 89.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 89, 91-100, 119-121 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5676250 to Walters.
12. The Walters reference teaches, and shows in Figures 5 and 6, a substantially planar semi-rigid backer 16 having openings through which the tying element 40 is inserted. The ornamental item, which is the light string 12, is secured by the tying element. The opposite side of the backing element 16 is provided with hook or loop fastener material having a first surface abutting the backing element 16, and a second surface to be removeably engaged to a mating portion of hook or loop fastener. The

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hook or loop fastener attached to the light string may be removeably attached to a mating piece of hook and loop fastener 38. The mating piece of hook and loop fastener has a first surface abutting the object to which the light string is to be attached, such as along a roof line for outdoor decoration (see Figure 5) or to a cylinder for storage (see Figure 1), and a second engageable surface that engages the second surface of the first fastener. Thus, the structural limitations of claims 89, 93, 95, 99, and 119-121 are met.

13. Regarding claim 91 and 92, the examiner takes official notice that a variety of Velcro constructions are well-known in the art, including "plastic" backing materials such as polymer fabrics, and that it would have been obvious to determine and use a thickness to provide adequate support for the hook and loop elements. Absent a showing of unexpected results with the claimed materials and thickness, Applicant does not appear to have claimed anything beyond what is known in the fields of material and textile engineering.

14. Regarding claim 94, the ultimately intended ornamental item does not effect the structure of the fastener itself. Therefore, although the reference teaches attachment of a light string, as opposed to the items listed in claim 94, the structural limitations are met and would not be any different if any of the items of claim 94 were used instead of a light string. Thus it can be seen that the ultimate intended uses of claim 94 do not provide patentable distinction to the attachment mechanism.

15. Regarding claims 96, 97, 98, and 100 it has been held that altering shapes and sizes requires only routine skill in the art, and does not provide patentable distinction

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absent a showing that the modification actually changes the way the item functions. In the present situation, changing the shapes of the holes through the backer does not change the way the backer functions, therefore no patentable distinction is provided.

Response to Arguments

16. Applicant's arguments filed 3/16/06 have been fully considered but they are not persuasive. Applicant argues that the structure alleged by the examiner to be analogous to the backer does not actually meet the claim limitations. Applicant's argument is that the backer and the hook or loop portion of the hook/loop fastener are not separate elements, as claimed. The argument is not commensurate with the claims; separate elements are not required. A variety of Velcro constructions are well-known in the art, including "plastic" backing materials such as polymer fabrics, and that it would have been obvious to determine and use a thickness to provide adequate support for the hook and loop elements.

Conclusion

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

18. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the

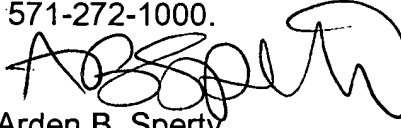
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arden B. Sperty whose telephone number is (571)272-1543. The examiner can normally be reached on M-Th, 08:00-16:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (571)272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Arden B. Sperty
Examiner
Art Unit 1771

May 22, 2006


CHERYL A. JUSKA
PRIMARY EXAMINER